

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08350.1328-00000

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on _____

Signature _____

Typed or printed name _____

Application Number

10/016,385

Filed

October 26, 2001

First Named Inventor

William E. TAYLOR

Art Unit

3627

Examiner

Joseph A. Fischetti

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☐

attorney or agent of record.

Registration number _____

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 55,288

SignaturePanyin A. Hughes

Typed or printed name

(202) 408-4324

Telephone number

July 27, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Customer No. 58,982
New Attorney Docket No. 08350.1328

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: |) | |
| |) | |
| William E. TAYLOR |) | Group Art Unit: 3627 |
| |) | |
| Application No.: 10/016,385 |) | Examiner: Joseph A. Fischetti |
| |) | |
| Filed: October 26, 2001 |) | |
| |) | |
| For: SYSTEM AND METHOD FOR |) | Confirmation No.: 4949 |
| DETERMINING TAXES FOR |) | |
| EQUIPMENT CONTRACTS |) | |

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections set forth in the final Office Action mailed on April 27, 2006. Applicant respectfully asserts that (1) the application has been at least twice rejected; (2) this request is being filed concurrently with a Notice of Appeal; (3) this request is being filed prior to an Appeal Brief; and (4) this request is five or less pages in length, all in accordance with the guidelines set forth in the Official Gazette Notice of July 12, 2005. Applicant requests the prompt review of the Examiner's rejections set forth in the final Office Action.

Obviousness Rejection

In the final Office Action, claims 1-7, 9-23, 48, and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,067,531 to Hoyt et al. ("Hoyt") in view of U.S. Patent 6,298,333 to Manzi et al. ("Manzi") and U.S. Patent 5,724,523 to Longfield ("Longfield"). A *prima facie* case of obviousness requires, inter alia, that the prior art references, when combined, must teach or suggest every aspect of the claims. M.P.E.P. § 2143.

Applicant respectfully asserts that none of Hoyt, Manzi, and Longfield, either alone or in any combination, disclose or suggest each and every element as set forth in the claims. For example, with respect to independent claim 1, none of Hoyt, Manzi, and Longfield, alone or in any combination, disclose or suggest, among other aspects, "[a] computer based method for automatically determining taxes for a contract for equipment, including . . . selecting a paying party from a group of paying parties, to pay the tax amount, as a function of the set of tax rules."

The Office Action concedes that neither Hoyt nor Manzi, or a combination thereof, disclose the above recited recitation. Specifically, the office action states: "the above combination [of Hoyt and Manzi] appear silent regarding the feature of selecting a paying party from a group of paying parties to pay the tax amount as a function of the set rules." Office Action at page 3. Nevertheless, the Office Action contends that "Longfield discloses plural paying parties, namely an authorized preparer or an authorized financial institution," adding that "depending upon a given set of rules which are established in advanced, selecting one to be the payor." Office Action at page 3. Applicant submits that the Office Action mischaracterizes Longfield.

Longfield discloses “an electronic data processing system for preparation of electronically filed tax returns and authorization and payments of refunds based on the data supplied in those returns.” Longfield, Abstract. Longfield further discloses that “[a]t the same time as the electronic tax return is created a loan application is processed to create an electronic deposit/loan account for the tax filer at an authorized credit union.” Longfield, Abstract. Longfield adds that [t]he tax filer can receive a loan or use the tax refund as collateral for a secured credit card,” suggesting that the “maximum authorized amount of refund anticipation loan is processed by determining whether or not payment is to be made through an authorized preparer 90 or directly by the authorized financial institution 100.” Longfield, Abstract, and col. 3 lines 41-45. In other words, Longfield discloses making tax refunds available to tax filers in the form of a loan or a secured credit card. The “paying parties, namely an authorized preparer or an authorized financial institution” disclosed in Longfield are not parties paying taxes to the IRS. Rather, these parties grant loans to taxpayers anticipating a refund. Indeed, nowhere does Longfield disclose a payor paying taxes to the IRS.

The office action insists that Longfield discloses “the selecting of a payor,” and that Manzi discloses rules applied to determine taxes on equipments, citing IRS Pub 1345. Office Action at page 5. Once again the office action confuses a taxpayer (or tax filer) paying taxes to the IRS with a taxpayer receiving a tax refund from the IRS. Independent claim 1 recites “selecting a paying party from a group of paying parties, to pay the tax amount, as a function of the set of tax rules.” That is, selecting a payer to pay taxes to the IRS, not to receive a tax refund. The office action essentially equates receiving a tax refund with paying taxes. These two events, however, are directly

opposed. Longfield discloses granting a loan or credit based on the taxpayer's tax refund, not paying taxes to the IRS. As is well known, a person or party paying taxes does not receive a refund. Thus, as Longfield discloses receiving a refund, it cannot teach paying taxes. The IRS publication the office action relies on dictates rules that financial institutions providing refund anticipation loans should abide by. It does not provide rules on selecting a paying party from a group of paying parties, to pay the tax amount, as required by claim 1. Accordingly, Applicant submits that Hoyt, Manzi, and Longfield, either alone, or in combination fail to render claim 1 obvious and request withdrawal of the rejection against claim 1 and its dependents.

With respect to claim 23, similar to the arguments presented above, Applicant requests withdrawal of the section 103 rejection. As set forth above, Hoyt, Manzi, and Longfield, either alone, or in combination fail to disclose or suggest "selecting a paying party from a group of paying parties, to pay the tax amount, as a function of the set of tax rules," as recited in independent claim 23. Applicant thus requests withdrawal of the rejection against claim 23

Regarding the section 103(a) rejection of claim 49, similar to the arguments set forth above, neither Hoyt, Manzi, nor Longfield, alone, or in combination disclose, among other things, "selecting a paying party from a group of paying parties including a dealer, a financing company, and the customer, to pay the tax amount, based on the set of tax rules determined as a function of the customer location information, the contract characteristics, and the contract type," as recited in independent claim 49. Accordingly Applicant requests withdrawal of the obviousness rejection against claim 49.

Conclusion

For a more detailed account of Applicant's arguments traversing the rejections under 35 U.S.C. § 103(a) as set forth in the Final Office Action, reference is made herein to pages 8-12 of the Amendment filed in this application on February 6, 2006.

Because the 35 U.S.C. § 103(a) rejection of claims 1- 7, 9-23, 48, and 49 includes factual and legal deficiencies, Applicant is entitled to a pre-appeal brief review of the Final Office Action. Based on the foregoing arguments, Applicant requests that the rejection of these claims be withdrawn and the claims allowed.

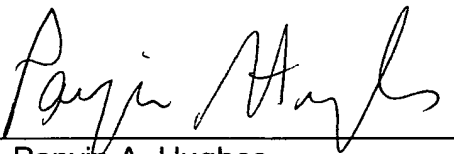
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 27, 2006

By: _____



Panyin A. Hughes
Reg. No. 55,288